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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/909,035	07/19/2001	Paul Steger		8475

25883 7590 06/04/2003
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EXAMINER

FRECH, KARL D

ART UNIT PAPER NUMBER

2876

DATE MAILED: 06/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/909,035

Applicant(s)

STEGER, PAUL

Examiner

Karl D Frech

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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1. The reissue oath/declaration filed with this application is defective because it fails to identify at least one error which is relied upon to support the reissue application. See 37 CFR 1.175(a)(1) and MPEP § 1414.
2. Claims 1-11 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Applicant proposes to amend current claims 1-11 to remove the limitation of the “bidirectional underwriting institution switch”. However, as seen in the prosecution history of the claims of the parent application 08/523,646, relating to claim 21 (for example) of papers numbers 12, 17 and 18, this “bidirectional underwriting institution switch” was specifically added in order to overcome the rejection based on Wright.

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3. Claims 12-40 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims added by the preliminary amendment of 7/19/01 contain subject matter much broader than that which is disclosed, claimed or shown in figures in the original applications reissue, or any of its parent. This subject matter out of the original scope of the original application for reissue is considered to be new matter. Although the applicant directs the examiner's attention to specific citations within the original application for reissue in order to show support for the now claimed subject matter, the examiner respectfully disagrees that this now claimed subject matter can reasonably construed from the original application for reissue. For example, in regard to claim 12, applicant cites col 4 line 33, lines 56-64, col 5 lines 9-17, lines 44-51 in order to provide support for the now claimed "to determine a destination" and "the destination based on the code". However, in review of the original application for reissue, it is disclosed that connection is made to a "financial institution". Although the examiner agrees that a "financial institution" may be a "destination", not all "destinations" (as now claimed) are "financial institutions". A "destination" may also be a network hub, for example. Thus, the now claimed "destination" is broader in scope than the original application for reissue allows. Similarly, regarding claim 13, the current claim calls for a "look up table" for a "destination" whereas the original application for reissue only encompasses a "look up table" for a "financial institution". Regarding claim 14, there is no support in the

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original application for reissue for the “electrical signals” and “using the electrical signals to access the look-up table.” Regarding claim 15, there is no support for the “bar code information referencing a destination”. Regarding claim 16, there is no support for “accessing a communication network to reach a “destination”. Regarding claim 18, there is no support for “accessing a destination”. Regarding claim 19, there is no support for “using a switch to reach a ‘destination’ based on the code”. Regarding claim 20, there is no support for “causing the switch to determine the ‘destination’ based on the code.” Regarding claim 21,27,34 there is no support for a data carrier “modulated” with an “index”, or a “pointer” for “pointing” to a “remote computer” on the network. Similar to that which is explained above, although the terms may be “similar”, they are not identical and can not be used interchangeably. Regarding the remaining dependent claims, some of the elements in these dependent claims are disclosed in the original application for reissue, such as the UPC and the EAN, but this does not negate the lack of disclosure to support their independent claims.

Any new matter due to the broadening of the original application for reissue, should be canceled from the application. The current claims in the this application for reissue is granted a filing date of the actual filing of this application for reissue for those elements which are new matter.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

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(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

5. Claims 12-40 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Hudetz et al 6,199,048. The examiner acknowledges that the applicant is attempting to provoke an interference in view of this Hudetz reference, however, as seen above, applicant is not entitled to the broader scope of invention of Hudetz. Hudetz predates the filing of the preliminary amendment in the current application for reissue.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karl Frech whose telephone number is (703) 305-3491. The examiner's supervisor is Michael Lee whose telephone number is (703)305-3503. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Tech Center receptionist whose telephone number is (703)308-0956. The Tech Center fax number is (703) 308-7722.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [karl.frech@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where

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there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

A handwritten signature in black ink, appearing to read 'Karl D. Frech', with a stylized, cursive script.

Karl D. Frech
Primary Examiner, AU 2876
June 02, 2003